

Notice of Allowability

Application No.

09/800,096

Examiner

Sudhaker B. Patel, D.Sc.Tech.

Applicant(s)

ANDERSSON ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/3/03.
2. ☒ The allowed claim(s) is/are 1,2,4-9,11-49 and 53.
3. ☒ The drawings filed on 06 March 2001 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 3 <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. _____ | 7 <input type="checkbox"/> Examiner's Amendment/Comment |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance:
2. Applicants' communication paper dated 11/03/03 is acknowledged.
3. Together with their earlier paper dated 3/31/03, applicants' had cancelled claims 3,10,50-52, and amended claims 14,7,8,11,1213,14,53. Therefore; the claims under consideration are the claims 1,2,4-9,11-49,53. These are renumbered as claims 1-48.
4. This application is RCE of allowed U. S. Sr. No. 09800096 filed 3/6//01.
Applicants had presented IDS paper # 21 dated 5/15/03, which was returned after signing the same together with earlier Office communication. The rejection issues related to 35 U.S.C. 102(b) raised by the examiner, were related to the subject matter covered by words " cyclic organyl group" in claim 1.
5. The rejections under 35 U.S.C. 102(b)/(e) are now withdrawn because applicants have clarified that the specification at page 9, lines 26-33 defined the term R as: " straight-chained organyl group as aryl group" which does not include methylpyrrolidinyl substituent on the piperidinyl moiety of the ref. '497. The definitions of instant Ar1 and R as recited in specification page 9, lines 20-25 do not encompass the aryl groups and phenyl groups with substituent of the ref. ' 665. Also, the definitions of Ar1 and R as recited in specification page 11, lines 8-19 do not include amino or substituted amino as substitutents onto the aryl/phenyl ring of ref. '165.
6. The closest prior art of record reference Marquis et al (WO 9850534) teaches making of compounds with a core:

" R5-NPiperidine-N H -CO-CH (Alkyl)-NH-R' wherein R5 and R' =Ar-Alkyl".

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The ref. '534 teaches the utility of the compounds as inhibitors of cathepsin K for treatment of diseases in which inhibition of bone loss is a factor.

The reference does not indicate or suggest arriving at the instant compounds having as core:

"H-N piperidine-N (Alkyl Ar1)-CO-CH2- Ar2 (= substituted Phenyl), wherein Ar1 and Ar2 can not be simultaneously unsubstituted phenyl".

7. Therefore, the instant invention of compounds of Group I is deemed to be novel and patentably distinct.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhaker B. Patel, D.Sc.Tech. whose telephone number is 703 308 4709. The examiner can normally be reached on 6:30 to 5:00 pm (Monday-Thursday).

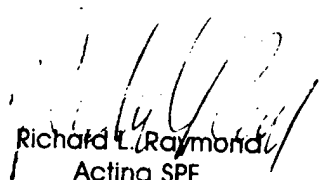
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund J. Shah can be reached on 703 308 4716 or Sr. Examiner Mr. Richard Raymond at (703) 308 4523.

The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 4556 for regular communications and 703 308 4556 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1235.


Sudhakar B. Patel, D.Sc.Tech.
December 8, 2003.


Richard L. Raymond
Acting SPE
MUKUND SHARMA
SUPERVISORY PATENT
EXAMINER
ART UNIT 1624